

REMARKS

Status of Claims

The Office Action mailed August 22, 2005, has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-17 were pending in the application. Claims 1 and 17 have been amended and no claims have been cancelled or newly added. Therefore, claims 1-17 are pending in the application and are presented for reconsideration.

This Amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier.

Prior Art Rejections

In the Office Action, claims 1 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,719,681 to Sasanuma (hereafter "Sasanuma") in view of U.S. patent 5,247,434 to Peterson (hereafter "Peterson"). Claims 2-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sasanuma in view of Peterson and U.S. patent 5,936,741 to Burns (hereafter "Burns"). Applicant respectfully traverses these rejections for at least the following reasons.

Claims 1 and 17 have been amended to recite, *inter alia*, that a specific *hidden* pattern is added (by a specific hidden pattern control signal synthesizing means/unit) on an output image when (1) a software control signal is supplied *and* (2) when it is determined that image data is supplied even if the software control signal is not supplied. These recited features are supported, for example, by the disclosure in the paragraph at lines 7-31 on page 7 of the specification. These features provide the advantage that a hidden pattern is necessarily added whenever a color image is supplied so that forgery or the like can be traced based on the hidden pattern. See also page 3, lines 15-20 of the specification.

Therefore, the present application discloses a color image forming apparatus in which an image formation output signal synthesizing means 19 adds a specific *hidden* pattern as long as image data exists even though the software control signal may indicate a state prohibiting addition of a hidden pattern due to an error (see lines 7-10 on page 7 of the

specification). Accordingly, a better result is obtained if a specific hidden pattern is necessarily added when a color image is outputted (see line 19-21 on page 7 of the specification). These recited features are not disclosed or suggested by the applied prior art.

Specifically, the office action states that Sasanuma discloses an image forming apparatus capable of forming a specific hidden pattern for specifying an apparatus (column 10, lines 30-33 of Sasanuma), comprises a hardware control signal supplying unit (an element 409 of FIG. 2 of Sasanuma), a software control signal supplying unit (a portion of an element 414 of FIG. 2 of Sasanuma), and a specific hidden pattern control signal synthesizing circuit (a portion of the element 414 of FIG. 2 of Sasanuma).

However, Sasanuma only discloses that “if this adding pattern represents to manufacture’s serial number exclusively assigned to the copying machine or encoded pattern of this number, the machine used for copying can be identified by examining the duplicates” (lines 29-33 of column 10, Sasanuma). The “adding pattern” of Sasanuma is quite different from the recited specific *hidden* pattern recited in the pending claims because Sasanuma does not intend for the added pattern to be hidden. For example, Sasanuma describes that the adding pattern is “ABCD and “1234” in the two rows being formed 64x64 pixels (column 10, lines 25-26 and Figure 14). In fact, Sasanuma teaches that “if there is a high possibility that a specific original is prohibited from copying exists in the read image, a more distinguishable pattern can be added on the image in black toner.” See col. 10, lines 34-37 of Sasanuma. Therefore, the image processing apparatus disclosed by Sasanuma does not cause the “adding pattern” to be hidden at all. Therefore, this recited feature is not disclosed or suggested by Sasanuma.

In addition, as acknowledged in the office action, Sasanuma does not disclose a specific hidden pattern being necessarily formed on the output image when (1) a software control signal is supplied *and* (2) when it is determined that image data is supplied even if the software control signal is not supplied. To cure this deficiency, the office action relies on Peterson. However, Peterson discloses an alarm being necessarily generated when either one of the hardware or software control signal exists in the context of alarm detection (secondary alarm) in the I/O electrical power board 536 of the computer system 500 which is used in method and apparatus for kidney dialysis. Such a redundant alarm system used in a medical

treatment device does not provide any reason for its use in the image processing system like that recited in the claims or disclosed by Sasanuma. For example, generation of an alarm at the time of forgery (in a private location) would not provide the ability to trace back the machine used in the forgery as recited in the pending claims or as disclosed by Sasanuma.

Furthermore, a kidney dialysis apparatus is a completely different field of art than the claimed image processing apparatus and one skilled in art of image processing machines would not look to the field of kidney dialysis machines for a solution since neither the requirement of an alarm or the immediate intervention required for medical treatment is present in the case of image processing machines. Accordingly, these two apparatus are in completely different arts and there is no motivation to combine these references other than impermissibly using the applicant's own invention as a roadmap. Therefore, there is no motivation whatsoever to combine the references in the manner proposed in the office action.

The remaining dependent claims are also allowable for at least the same reasons as the independent claims on which they ultimately depend. In addition, they recite additional patentable when considered as a whole.

In view of the foregoing amendments and remarks, applicant submits that the application is now in condition for allowance. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is courteously invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicant hereby petitions for any needed extension of time.

Respectfully submitted,

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